

REMARKS

Claims 1-3, 6, 12, 18-20, 24-27, 58-61 and 69-84 are pending in the application. Claims 1-3, 6, 12, 18-20, 24-27, 58-61 and 69-84 stand rejected.

I. REJECTION UNDER 35 U.S.C. § 112

Claim 83 stands rejected under 35 U.S.C. 112. The Examiner asserts that the claim is indefinite because of the phrase "such as". Applicants respond by amending claim 83 to address this situation.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 69, 74, 80-81, 84 and 91 stand rejected under 35 U.S.C. §103 as being unpatentable over *Eisdorfer et al.* (U.S. Patent No. 5,960,348) in view of *Petrunka et al.* (U.S. Patent No. 5,991,369). Claim 2 stands rejected under 35 U.S.C. §103 as being unpatentable over *Eisdorfer* as applied to claim 1 in view of *Petrunka* and further in view of *Lohman* (U.S. Patent No. 5,526,397). Claims 3 and 92 stand rejected under 35 U.S.C. §103 as being unpatentable over *Eisdorfer* in view of *Petrunka* and *Lohman* and further in view of *Pinede et al.* (U.S. Patent No. 4,554,413). Claims 24-27, 58-61, 71, 77-79 and 83 stand rejected under 35 U.S.C. §103 as being unpatentable over *Eisdorfer* in view of *Petrunka* and further in view of *Cho* (U.S. Patent No. 5,544,231). Claims 12 and 76 stand rejected under 35 U.S.C. §103 as being unpatentable over *Eisdorfer* in view of *Petrunka* and further in view of *Newlin* (U.S. Patent No. 6,011,579). Claim 73 and 82 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Eisdorfer* in view of *Petrunka* as applied to claim 1 above.

In response, Applicants respectfully traverse these rejections. As permitted under MPEP §201.11, Applicants may request a corrected filing receipt to include the benefit claim of a prior application. Concurrently herewith, Applicants are also filing a petition and surcharge as required. The benefit is now being made to the parent application, which also claims benefit to United States Provisional Application Serial No. 60/023,749 which was filed on June 12, 1996.

This results in the *Petrunka* reference no longer being valid prior art. Therefore, the above rejections are overcome.

Claims 18-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Eisdorfer* in view of *Cho* (U.S. Patent No. 5,544,231) and further in view of Han (U.S. Patent No. 5,991,397). In response, Applicants respectfully traverse these rejections.

In the Examiner's rejection on page 10 of the office action, the Examiner makes very cursory remarks, and does not tie together how the combination of *Eisdorfer*, *Cho* and Han make obvious the limitations within claims 18 and 19. For example, with respect to *Cho*, all the Examiner asserts is that "[w]hen recording the conversation as taught by *Cho*, the calling and called parties must be on an off-hook state." Thus, the Examiner does not do a very good job of particularly pointing out how the prior art references reject claims 18 and 19, which is not proper under the MPEP. An Examiner is required to point out with particularity how the prior art references are used and can be combined to reject the claims.

In *Eisdorfer*, voice processing unit 116 is merely a voice recognition unit. Col. 4, line 51. *Eisdorfer* does not disclose that voice processing unit 116 automatically interacts with a call directed to a voice mailbox if a user of the telecommunications device does not answer the call.

Furthermore, the Examiner has asserted that the telecommunications devices are taught in *Eisdorfer* as items 169 and 101. Applicants traverse. 169 is not an extension coupled to the system 105 or 131, but is at most possibly an extension of the Home MSC 161. System 159 is not part of system 105 or 131. Recall that the system recited in claim 69 has voice processing circuitry and switching circuitry controlled by a single microprocessor. Main processor 107, which the Examiner asserts is equivalent to a the single microprocessor recited in the claim does not control anything within system 159. Therefore, cell phone 169 is not part of system 105. Likewise, telephone 101 is also not part of the system 105 or 131, but is instead a telephone extension at most of a local exchange carrier (LEC) 103. LEC 103 is also not controlled by main processor 107. One skilled in the art would clearly understand that telephones 101 and 169 are not extensions to the system, as specifically recited within claim 69.

There is also nothing taught within Eisdorfer that the switch fabric 118 connects an incoming call to either of telephones 101 or 169 based on information accompanying an incoming call that identifies those particular telephones. It is more likely that switch fabric 118 may merely switch the incoming call, based on information it receives with the call, to the LEC 103 or Home MSC 161, and then it is up to those switch systems to determine what connected telephone the incoming call should be switched to.

The Examiner's motivation is provided in paragraph 18 of page 10 of the Office Action. The problem with this stated motivation by the Examiner is that it is the Examiner's own subjective opinion, and is not supported with any objective evidence. An Examiner's subjective opinion does not amount to objective evidence. Yet still further, the Examiner's motivation to combine the references is only stated as combining Eisdorfer with Han. The Examiner thus does not provide any reasoning as to why one skilled in the art would combine Eisdorfer, Han and Cho. Furthermore, the system in *Eisdorfer* is an interexchange telephone carrier system, and has no need to record conversations. The voice processing unit 116 in *Eisdorfer* is merely a voice recognition unit. Any voice conversations recorded by voice processing unit 116 would not even be accessible by any telephone devices, such as devices 101 and 169 noted in *Eisdorfer*. In other words, telephone 101 would not be able to access any recorded voice conversations in voice processing unit 116, and neither would telephone 169. One skilled in the art at the time the invention was made, looking at Eisdorfer, Cho, and Han would thus not be able to recreate the claimed invention. Furthermore, such a person skilled in the art would not have combined these references to arrive at the claimed invention, since there is no motivation to modify Eisdorfer to record voice conversations. As a result, the Examiner has failed to prove a prima facie case of obviousness.

Claims 6 and 75 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Eisdorfer* in view of *Van Berkum et al.* (U.S. Patent No. 6,028,925). In response, Applicants respectfully traverse this rejection. First, Applicants respectfully assert that the Examiner has not addressed Applicants' previous traversals of this rejection, which is in violation of MPEP § 707.07(f).

The combination of *Van Berkum* and *Elsdorfer* does not meet the claim limitations. *Van Berkum* merely teaches that the various software programs are executed by control processor 116 to service the telephone calls. However, there is no voice processing circuitry taught or suggested within *Van Berkum* that is also controlled by this set of software programs. At the most, voice response unit 108 is taught within *Van Berkum* as being separate from and therefore not controlled by the software programs and the control processor 116. As a result, the combination of *Van Berkum* and *Elsdorfer* still teaches away from the present invention. A combination of the two references would not teach to one skilled in the art at the time the invention was made that voice processing circuitry and switching circuitry could be controlled by a single set of software. Recall that claim 6 does not merely recite that the single processing means is controlled by a single set of software, but instead, claim 6 further recites that the switching circuitry and the voice processing circuitry are controlled by such a single processing means. Claim 6 further recites that this single set of software is operable for controlling both the switching circuitry and the voice processing circuitry. The Examiner has not even addressed this claim limitation. Thus, the Examiner has failed to prove a *prima facie* case of obviousness.

Regarding claim 75, the rejection is further traversed for similar reasons as given above with respect to claim 81.


Claim 20 stands rejected over *Elsdorfer*, *Cho* and *Newlin*. Applicants traverse and incorporate all arguments above. Note further that none of the cited references, singularly or in combination, teach or suggest that signal processing circuitry includes a recording buffer. In fact, the Examiner has failed to specifically address this claim language. Further *Newlin* lists several DSP functions in the language cited by the Examiner, but specifically does not list recording buffer. Program memory and data memory as recited in *Newlin* is not the same as a recording buffer.

Claim 70 stands rejected as being unpatentable over *Eisdorfer* in view of *Pinede*. Applicants respectfully traverse this rejection. *Pinede* does not disclose a voice processing circuitry coupled to the crosspoint matrix 52. As such, one skilled in the art at the time the invention was made, would not have been motivated to combine *Pinede* with *Eisdorfer* in order to combine the crosspoint matrix 52 of *Pinede* with the system described in *Eisdorfer*. The Examiner has relied solely on hindsight reasoning in finding a teaching in *Pinede* of a crosspoint matrix and combining it with *Eisdorfer*. There is nothing within *Eisdorfer* that teaches or suggests that the switch fabric 118 could be a crosspoint matrix. In fact, such a matrix would not work properly in the *Eisdorfer* system. Furthermore, there is nothing within *Pinede* that teaches or suggests that a crosspoint matrix as taught in *Pinede* could be used within a system such as *Eisdorfer*. Contrary to the Examiner's assertion, there is no need in *Eisdorfer* for the switch fabric to couple to multiple telephone stations. Instead, the switch fabric couples other switches together. And, the Examiner's stated motivation is merely the Examiner's subjective opinion, which is insufficient to support a motivation to combine the references.

Claim 72 stands rejected under 35 U.S.C. § 103 as being unpatentable over *Eisdorfer* in view of *Bertocci* (U.S. Patent No. 5,953,656). Applicants traverse for reasons as given above with respect to the use of *Eisdorfer* to reject the claims.

Please apply any necessary charges or credits to deposit account 06-1050.

Respectfully submitted,



Kelly K. Kordzik
Reg. No. 36,571

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Fish & Richardson P.C.
One Congress Plaza, Suite 810
111 Congress Avenue
Austin, TX 78701
Telephone: (512) 226-8148
Facsimile: (512) 320-8935